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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. REDDIN, ROBERT J. GFELLER,
LAUREL M. KIMBROUGH, RODNEY D. TABERT,
THOMAS C. MCTHENIA, JR., and DANIEL J. WARREN

Appeal 2010-011501
Application 09/296,120
Technology Center 3600

Before: BIBHU R. MOHANTY, MEREDITH C. PETRAVICK, and
MICHAEL W. KIM, *Administrative Patent Judges.*

KIM, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1, 2, 4-19, 21-23, 25-28, 30-45, and 59-65¹. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002).

The claimed invention is directed to methods for marketing a product based upon consumers' lifestyles, activities, and needs (Spec. 1:17-20). Claim 1², reproduced below, is further illustrative of the claimed subject matter.

1. A method for promoting the selection of an item by a predetermined type of consumer based upon consumer lifestyle and consumer market data, said method comprising the steps of:

storing the consumer lifestyle and the consumer market data in a database;

storing a selection of messaging, brands, packaging, or merchandising associated with the item in the database;

determining one or more representative activities of said predetermined type of consumer based upon the consumer lifestyle data via a processor in communication with the database;

determining one or more representative uses of said item by said predetermined type of consumer during said one or more representative activities based upon the consumer market data via the processor in communication with the database;

determining an association between said one or more representative uses of said item by said predetermined type of consumer during said one or more representative activities and the selection of messaging, brands, packaging, or merchandising via the processor in communication with the database;

¹ Claim 66 is withdrawn (App. Br. 2).

² We refer to the claims set forth in Appendix A of the Reply Brief, which includes the amendments submitted on January 30, 2009, and entered on August 18, 2009 (Exam'r's Ans. 18; Reply Br. 3).

storing the association in the database; and
providing access to the database and the association.

Claims 1, 2, 4-19, 21-23, 25-28, 30-45, and 59-65 stand rejected under 35 U.S.C. § 102(b) as anticipated by Deaton (US 5,649,114, iss. Jul. 15, 1997)³; and claims 1 and 59 stand rejected under 35 U.S.C. § 102(e) as anticipated by Anderson (US 5,974,396, iss. Oct. 26, 1999).

We REVERSE.

ISSUES

Did the Examiner err in asserting that Deaton anticipates independent claim 1⁴? The issue turns on whether Deaton discloses both “representative activities” and “representative uses,” as recited in independent claim 1.

Did the Examiner err in asserting that Anderson anticipates independent claim 1⁵? The issue turns on whether Anderson discloses both “representative activities” and “representative uses,” as recited in independent claim 1.

ANALYSIS

Rejection over Deaton

We are persuaded the Examiner erred in asserting that Deaton anticipates independent claim 1 (Appeal Br. 13-18). Deaton discloses

³ The rejection of claims 59-65 under 35 U.S.C. § 101 is withdrawn (Exam’r’s Ans. 3, 16).

⁴ We choose independent claim 1 as representative of independent claims 1 and 59. See 37 C.F.R. § 41.37(c)(1)(vii).

⁵ We choose independent claim 1 as representative of independent claims 1 and 59. See 37 C.F.R. § 41.37(c)(1)(vii).

storing customer identification data, such as home address geographic data, and consumer purchase history data, such as coffee brands (col. 62, ll. 9-62; col. 70, ll. 56-59; col. 71, ll. 31-37). The Examiner asserts that these disclosures correspond to the recited “consumer lifestyle and the consumer market data” (Exam’r’s Ans. 3-4, 18-19, 20-22). We agree, particularly with the fact that the Specification supports the construction that the demographic and socioeconomic information disclosed in Deaton are forms of consumer lifestyle information (11:30-34).

The Examiner then asserts, however, that “[i]t is herein understood if a customer purchases a certain type of coffee brand, then the customer will prepare and drink the coffee while watching TV, talking to a friend on the phone, reading a newspaper, etc., (so called representative activities)” (Exam’r’s Ans. 5). However, none of the aforementioned “activities” are disclosed in the portions of Deaton cited by the Examiner.

The Examiner also asserts that “what the customer is doing or the kind of action performed by the customer (herein referred to as representative activities) while consuming an item is not a matter of patentability or should not be given any patentable weight here)” (Exam’r’s Ans. 5). In effect, the Examiner is asserting that “representative activities” are non-functional descriptive material. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). However, prior to considering this, there are several threshold issues.

First, in order to apply the doctrine of non-functional descriptive material, the Examiner must first show the disclosure in Deaton that

corresponds to the claimed aspect, exclusive of content. Second, independent claim 1 recites “determining one or more representative uses of said item by said predetermined type of consumer during said one or more representative activities.” Accordingly, Deaton must actually disclose two sets of data, where one is related to the other. In other words, as applied to this case, the Examiner must first show two related data sets in Deaton that correspond to the recited “representative uses” and “representative activities,” even if the content of the data sets do not include “activities” and “uses,” respectively.

To that end, we agree with Appellants that since Deaton does not disclose any data sets that correspond to “watching TV, talking to a friend on the phone, reading a newspaper,” we are left with “drinking coffee” from the Examiner’s example. However, the Examiner asserts that “drinking coffee,” and its respective data sets in Deaton, already corresponds to “representative uses” (Exam’r’s Ans. 5-7, 16-17). *See Texas Instr., Inc. v. U.S. Int’l Trade Comm’n*, 988 F.2d 1165, 1171 (Fed. Cir. 1993) (claim language cannot be mere surplusage. An express limitation cannot be read out of the claim); *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1563 (Fed. Cir. 1991) (two distinct claim elements should each be given full effect).

Accordingly, because the Examiner has not shown how Deaton discloses data sets for both “representative activities” and “representative uses,” we are constrained to reverse this anticipation rejection.

Rejection over Anderson

We are persuaded the Examiner erred in asserting that Anderson anticipates independent claim 1 (Appeal Br. 20). Anderson discloses “[t]argeting of specific consumers with marketing and other promotional literature is based on consumer buying habits, needs, demographics, etc.” (col. 3, ll. 1-3). However, the Examiner has not shown which aspects of “consumer buying habits, needs, demographics, etc.” respectively correspond to the recited “representative uses” and “representative activities.” We encounter the same problem as in the rejection over Deaton, where perhaps one of ordinary skill could infer “representative uses,” such as drinking coffee, from a consumer’s buying habits in Anderson. However, the Examiner has not shown how Anderson, either implicitly or explicitly, discloses “representative activities” in addition to those “representative uses.” Accordingly, we do not sustain this rejection.

DECISION

The decision of the Examiner to reject claims 1, 2, 4-19, 21-23, 25-28, 30-45, and 59-65 is REVERSED.

REVERSED

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